

REMARKS

Applicants would like to thank the Examiner for the careful consideration given to the present application. The present application currently has claims 1-15 pending. Applicants have added new claims 25 and 26. The application has been carefully reviewed in light of the Office Action, and claims 1 and 10 have been amended to address the issues raised by the Examiner. Further, claim 8 has been amended to be consistent with the antecedent basis provided in Claim 1. Applicants respectfully submit that the claims are patentable over the cited references for at least the reasons set forth below. Reconsideration of this application is hereby requested.

Claim Rejections – 35 U.S.C. 103

The Examiner has rejected claims 1-3 and 10-13 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al (U.S. Patent No. 6,112,665). Applicants traverse this rejection for the following reasons.

In order to establish *prima facie* obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). Claims 1 and 10 have been amended to claim elements that are not disclosed in either the Dohse patent or the Teter et al. patent. In particular, the amendment recites that the first surface has a surface area that is coated in its entirety with a layer of a first colored coating composition. Neither Dohse nor Teter et al. teach a color card that has the surface area of a first surface coated in its entirety with a single coating composition. In fact, the Teter et al. patent contemplates that a plurality of computer generated color swatches appear on one side of a color card (col. 2, lines 22-24; col.4, lines 43-44). Therefore, it is respectfully submitted that the Dohse and Teter et al. patents do not teach or suggest all of the limitations disclosed in claims 1 and 10, and the Examiner has not established a *prima facie* case of obviousness with respect to claims 1 and 10. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, claims 2-3 and 11-13 are nonobvious and patentable over the Dohse in view of Teter et al.

The Examiner has rejected claims 4 and 14 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al. as applied to claims 1 and 10, and further in view of Spangler (U.S. Patent No. 6,270,123). The Examiner states that Dohse discloses Applicants' basic inventive concept except for making the color card out of paper. Applicants traverse this rejection for the following reasons. In light of the amendments to claims 1 and 10, the Examiner's rejection of claims 4 and 14 appear to be moot. The amendments to claims 1 and 10 require an element that is not disclosed in either the Dohse or Spangler patent, namely that the surface area of the first surface is coated in its entirety with a first colored coating composition. Accordingly, claims 4 and 14 are nonobvious and patentable over Dohse in view of Spangler.

The Examiner has rejected claims 5-7 and 15 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al, and further in view of Day et al (U.S. Patent No. 4,104,809). With respect to claims 5-7 and 15, the Examiner has stated that Dohse discloses the idea of placing indicia on each chip section to indicate the color of the paint chip but does not disclose placing a formula for the paint color. Moreover, the Examiner states that Day et al. shows the idea of placing indicia for indicating the color of each chip section and indicia for indicating a code/formula for each chip section. Applicants traverse this rejection for the following reasons.

In light of Applicants' amendment to claims 1 and 10, Applicants submit that the combination of Dohse in view of Teter et al. and further in view of Day is not obvious, as none of these references disclose the element that Applicants have added through the current amendment to independent claims 1 and 10. Accordingly, claims 5-7 (which are dependent from claim 1) and claim 15 (which depends from claim 10) are not obvious.

Lastly, the Examiner rejects claims 8 and 9 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Teter et al. as applied to claim 1 and further in view of Edwards (U.S. Patent No. 4,992,050). The Examiner states that Dohse discloses the applicant's basic inventive concept except for placing a color coating on the back of each chip section. Further, the Examiner states that Edwards discloses in the abstract the idea of placing a first color of paint on a first side of a chip section and a coating of paint on the opposite side the chip section. Additionally, the Examiner states that Edwards discloses that the paint on the second side has a different finish as compared to the first side. The Examiner also states that in regard to claim 8,

it would be obvious to place a coat of paint on the second surface of a chip section. Applicants traverse this rejection for the following reasons.

With respect to claim 8 (as amended), the Examiner has not shown that the element of placing the same colored coating composition on the second surface of the paint card as appears on the first surface is disclosed by Edwards. In fact, the Edwards patent only contemplates use of the same color with different finishes, and therefore different compositions, on each side of the color sheet (see Col.6, lines 5-12). In the Office Action (page 5, lines 5-6), the Examiner states that “the colors on each side of the paint chip sections of Edwards are considered to be of the same color *but would have different compositions.*” Because Edwards does not disclose the use of the same composition on both sides of the color card, such element is not found in the combination of references that the Examiner cites, and therefore Applicants claim 8 cannot be obvious in light of such references.

Additionally, Applicants disagree with the Examiner’s assertion that it is considered within one skilled in the art to place the same color on the back of each chip section as on the front. Suing the same color on both surfaces is not obvious for many reasons, one example of which is that doing may be less economically advantageous to the manufacturer of the card and therefore not seen as an obvious step to take. The lack of Examiner’s findings of art that describes the use of the same composition on both sides of a paint color card, particularly when the Edwards patent itself contemplates using both sides of a color card, but with *different finishes*, appears to indicate that claim 8 is not within one skilled in the art. Furthermore, the amendment that Applicants have made to claim 1 add an additional element to claim 1 and its dependent claim and as stated above, such element is not found in the cited references.

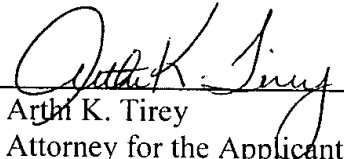
With respect to claim 9, the Examiner states that the colors on each side of the paint strip sections of Edwards are considered to be of the *same color* but would have different compositions. Applicants’ claim 9 claims that the first colored coating composition is a different color than the second colored coating composition. Therefore, the Dohse in view of Edwards does not teach all of the claim elements present in Applicants’ claim 9. Furthermore, in light of the amendment to claim 1, Dohse in view of Edwards does not disclose a paint card that includes all of the claimed elements as in the subject application.

Accordingly, claims 8 and 9 are nonobvious and patentable over Dohse in view of Teter and further in view of Edwards.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If the Examiner has any questions with respect to the foregoing, he is invited to contact the undersigned. Applicants would like to again thank the Examiner for his review of the subject application.

Respectfully submitted,

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